

REMARKS/ARGUMENTS

Upon entry of the above amendment, claims 13, 19 and 24-25 will have been amended and claims 13-25 thus remain pending for reconsideration by the Examiner. In view of the above, Applicant respectfully requests reconsideration of the outstanding rejections of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided.

Applicant also notes with appreciation the Examiner's acknowledgment of Applicant's Information Disclosure Statements filed in the present application on April 29, 2002 by the return, inter alia, of the initialed and signed front page, and for consideration of the documents cited in the Information Disclosure Statement.

Turning to the merits of the action, the Examiner has rejected claims 13-14 under 35 U.S.C. § 103(a) as being unpatentable over RODWIN et al. (U.S. Patent No. 5,812,819) in view of ITOH (U.S. Patent Publication No. 2001/0021037). The Examiner has rejected claim 15 under 35 U.S.C. § 103(a) as being unpatentable over RODWIN et al. and ITOH in view of SAWYER et al. (U.S. Patent No. 6,466,986). The Examiner has rejected claims 16-25 under 35 U.S.C. § 103(a) as being unpatentable over RODWIN et al. and ITOH in view of ROY et al. (U.S. Patent Publication No. 2002/0062366) and KUMPF et al (U.S. Patent No. 6,839,755).

As noted above, Applicant has amended claims 13, 19 and 24-25, and claims 13-25 remain pending. Applicant respectfully traverses the above rejections based on the pending claims 13-25 and will discuss the outstanding rejection with respect to

these claims in the present application as will be set forth hereinbelow. The amendments to the claims merely clarify the subject matter recited in the rejected claims, but do not narrow the scope of the claims.

Applicant's claims 13-18 generally relate to a scanner apparatus which scans image data and comprises an interface configured to be connected to a terminal apparatus via a network. The terminal apparatus is configured to be connected to a DHCP (Dynamic Host Configuration Protocol) server via the network. The DHCP server assigns one IP address to the terminal apparatus. The one IP address is assigned to the terminal apparatus for a predetermined time period. The scanner apparatus also comprises a controller which receives, from the terminal apparatus, the one IP address assigned to the terminal apparatus, and transmits the scanned image data to the terminal apparatus during the predetermined time period, based on the received one IP address assigned to the terminal apparatus. Further, the controller receives, from the terminal apparatus, another IP address assigned to the terminal apparatus when the predetermined time period elapses, the another IP address being assigned to the terminal apparatus for a further predetermined time period by the DHCP server, and transmits the scanned image data to the terminal apparatus during the further predetermined time period, based on the another IP address assigned to the terminal apparatus. The another IP address is distinct from the one IP address. Claims 19-23 recite related terminal apparatuses. Claim 24 recites a related system. Claim 25 recites a related method.

In direct contrast, RODWIN et al. relates to a remote access device which receives a user name from a remote computer and obtains an IP address from a server

on the network. The server assigns the IP address based on the user name. The IP address identifies the remote computer. When a user at the remote computer disconnects (or is disconnected) from the network (Fig. 4A step 54) and attempts to re-gain access to the network by sending the same user name (Fig. A4A step 56), the remote access device obtains the same IP address from the server (Fig. 4A step 58 and col. 8, lines 18-28).

However, RODWIN et al. does not disclose a scanner apparatus which scans image data and transmits the scanned image data to the terminal apparatus. Rather, RODWIN et al. merely discloses a remote computer 12.

RODWIN et al. also does not disclose a scanner apparatus which receives, from the terminal apparatus, another IP address assigned to the terminal apparatus when the predetermined time period elapses, as recited in, e.g., claim 13. Rather, RODWIN et al. discloses the remote access device 16 which obtains the same IP address from the server 30 (Fig. 4A step 58) when the remote computer 12 disconnects from the network and attempts to re-gain access to the network by sending the same user name (Fig. 4A steps 54 and 56).

RODWIN et al. also does not disclose that another IP address is assigned to the terminal apparatus when the predetermined time period elapses as recited, e.g., in claim 13. In this regard, Applicant respectfully directs the Examiner's attention to col. 8, lines 51-54 wherein RODWIN et al. explicitly discloses that the reconnection (with the same IP address) "must occur before the lease expires on the IP address dynamically assigned to the user's remote computer".

On the other hand, a scanner apparatus of the present invention recites a controller which receives, from the terminal apparatus, the one IP address assigned to the terminal apparatus and transmits the scanned image data to the terminal apparatus during the predetermined time period, based on the received one IP address assigned to the terminal apparatus, and recites a controller which receives, from the terminal apparatus, another IP address assigned to the terminal apparatus when the predetermined time period elapses, the another IP address being assigned to the terminal apparatus for a further predetermined time period by the DHCP server, and transmits the scanned image data to the terminal apparatus during the further predetermined time period, based on the another IP address assigned to the terminal apparatus. Applicant respectfully submits that the another IP address recited in the claims is distinct from the one IP address. In this regard, by the present amendment, Applicant has amended rejected claims to clarify this aspect of the scope of the invention. Thus, Applicant submits that the pending claims are clearly distinguished over RODWIN et al.

Although Applicant believes that the previously pending claims, which recite one IP address and another IP address, adequately recite that two different IP addresses are utilized according to the teachings of the present invention, in order to even more clearly emphasize this distinction between Applicant's claimed invention and the RODWIN et al. reference, Applicant has now explicitly recited that the another IP address is distinct from the one IP address. This explicit recitation does not raise new issues that require further consideration or search. Rather, it is respectfully submitted

that the language previously utilized adequately sets forth this distinction. Applicant's amendment merely serves to more explicitly define this feature.

Therefore, it is respectfully submitted that the features recited in Applicant's claims 13-25 are not disclosed in RODWIN et al. cited by the Examiner.

In setting forth the rejection, the Examiner admitted that RODWIN et al. fails to disclose receiving the IP address from the terminal apparatus and transmitting scanned image data to the terminal apparatus. The Examiner relied on ITOH for these features. However, Applicant submits that the disclosure of ITOH is inadequate and insufficient to supply the deficiencies noted to exist in the RODWIN et al. disclosure.

ITOH relates to a network scanner apparatus which produces an image data signal, inputs an IP address as a transmitting destination of the image data signal (Fig.7, S2 or S3), and transmits the image data signal to the terminal having the input IP address (Fig. 7 S9).

However, ITOH does not disclose a scanner apparatus which transmits the scanned image data to the terminal apparatus during the predetermined period based on one IP address assigned to the terminal apparatus and transmits the scanned image data to the terminal apparatus based on the another IP address assigned to the terminal apparatus, when the predetermined period elapses. Rather, ITOH merely discloses a network scanner apparatus which inputs the IP address as the transmitting destination via the operation portion 1 (paragraph [0106]) and transmits the image data signal to the terminal based on the IP address input via the operation portion 1 (paragraph [0114]). In other words, ITOH does not teach another IP address that is

assigned to the terminal apparatus when the predetermined period elapses. Thus, Applicant submits that the pending claims are clearly distinguished over ITOH.

Thus, neither RODWIN et al. nor ITOH (nor, inherently, any combination of the two) teaches the assignment of one IP address for a predetermined period of time and the assignment of another IP address for a further predetermined period of time, when the predetermined period of time elapses. As previously noted, RODWIN et al. deals with a single IP address and reconnection thereto is explicitly disclosed to take place prior to the expiration of the lease for the IP address. ITOH, since it only deals with a single connection utilizing only a single IP address, clearly does not disclose these features. Thus, no proper combination of ITOH and RODWIN et al. can be adequate to render Applicant's claims unpatentable.

Therefore, it is respectfully submitted that the features recited in Applicant's submitted claims 13-25 are not disclosed in ITOH cited by the Examiner. Claims 13-25 are also submitted to be patentable over the Examiner's proposed combination, since neither of RODWIN et al. and ITOH, nor any proper combination thereof, disclose the combination of features recited in Applicant's claims 13-25.

Moreover, the Examiner has not set forth a proper motivation for the proposed combination. Without such proper motivation, the Examiner's combination is legally inadequate. The Examiner asserts that the combination "would have been obvious" without providing any evidence for such obviousness. Merely setting forth the ultimate conclusion (obviousness) does not satisfy the requirement for a proper motivation. The motivation set forth by the Examiner, to eliminate the use of a server apparatus is unsupported by RODWIN et al. In particular, RODWIN et al. relies upon the server 30

to provide the dynamic IP address assignment and management. Removing such a server based on some unspecified teaching of ITOH would not appear to result in an operative combination. Moreover, RODWIN et al. explicitly sets forth that the use of a server (such as the DHCP server 30 of RODWIN et al.) eliminates the need for a network manager to manually assign and track IP addresses. In contradiction to this, ITOH appears to disclose manual input of IP addresses. Thus, not only is there no motivation for the proposed combination of RODWIN et al. and ITOH, but the disclosures thereof appear to directly contradict each other and would thus render any proposed combination even more inappropriate.

With respect to claim 14, the Examiner's asserted motivation is also submitted to be inappropriate. In particular, the motivation relied upon by the Examiner ([0073]) refers to manual correction of data in the network setting memory portion 3. However, in RODWIN et al., the IP address is obtained from the DHCP server. Thus, the Examiner's proposed modification is not relevant to the combination of RODWIN et al. and ITOH.

The rejection of claim 15 under 35 U.S.C. § 103 as unpatentable over RODWIN et al. and ITOH and further in view of SAWYER et al. is also traversed. SAWYER et al. relates to a method and apparatus for providing dynamic host configuration protocol (DHCP) tagging. SAWYER et al. discloses a DHCP server which contains a lease record table 315. The lease record table 315 stores a lease period for a assigned IP address (Fig. 3 and col. 5, lines 5-24).

However, SAWYER et al. does not disclose a scanner apparatus which transmits the scanned image data to the terminal apparatus during the predetermined period

based on one IP address assigned to the terminal apparatus and transmits the scanned image data to the terminal apparatus based on the another IP address assigned to the terminal apparatus, when the predetermined period elapsed. Further, SAWYER et al. does not disclose a scanner apparatus which, when the controller receives from the terminal apparatus, the one IP address assigned to the terminal apparatus and the predetermined time period corresponding to the one IP address, stores, in the memory, the one IP address assigned to the terminal apparatus and the predetermined time period corresponding to the one IP address, and deletes the one IP address stored in the memory when the predetermined time period elapses.

Rather, SAWYER et al. merely discloses a lease record table 315 which stores a lease period for an assigned IP address (Fig. 3 and col. 5, lines 5-50). Further, in the portion cited by the Examiner (col. 5, lines 5-50), the computer system 120 appears to be considered (by the Examiner) the terminal apparatus recited in claim 15 and the DHCP server 140 appears to be considered (by the Examiner) the DHCP server recited in claim 15. However, the cited portion does not contain any disclosure regarding a component that can be considered to correspond to the scanner apparatus recited in claim 15. In claim 15, the scanner apparatus stores, in the memory, the one IP address assigned to the terminal apparatus for the predetermined time period corresponding to the one IP address, and deletes the one IP address stored in the memory when the predetermined time period elapses. Thus, claim 15 is clearly distinguished over SAWYER et al.

Therefore, it is respectfully submitted that the features recited in Applicant's submitted claim 15 is not disclosed in SAWYER et al. cited by the Examiner. Claim 15



is also submitted to be patentable over the Examiner's proposed combination, since neither of RODWIN et al., ITOH and SAWYER et al., nor any proper combination thereof, disclose the combination of features recited in Applicants' claim 15.

Applicant respectfully submits that the Examiner's rejection of claims 16-25 as unpatentable over the previously noted combination of RODWIN et al. and ITOH and further in view of ROY et al. and KUMPF et al. is also inadequate.

ROY et al. relates to a system in which the HTTP client 15 sends an HTTP request to the management station 5, the management station 5 sends the DLP broadcast request to a plurality of SNMP agents, the management station 5 receives from each of the plurality of the SNMP agents a response to the DLP broadcast request, and the management station 5 sends the HTML list of devices to the HTTP client 15.

However, ROY et al. does not disclose a scanner apparatus which receives, from the terminal apparatus, a predetermined packet, the predetermined packet being configured to search for the scanner apparatus connectable to the terminal apparatus, the predetermined packet including identification information, the identification information identifying the terminal apparatus, and transmits, to the terminal apparatus, a response to the predetermined packet when the identification information included in the predetermined packet matches identification information of the scanner apparatus. Rather, in applying ROY et al., the Examiner appears to be considering the HTTP client 15 as the terminal apparatus recited in, e.g., claim 16, and the SNMP Agent as the scanner apparatus recited in, e.g., claim 16. In ROY et al., the SNMP Agent receives from the management station 5, the DLP broadcast request, but does not receive

anything from the HTTP client 15. Similarly, in ROY et al., the SNMP Agent sends to the management station 5 a response to the DLP broadcast request, but does not send to the HTTP client 15 the response to the DLP broadcast request. On the other hand, in the present invention, the scanner apparatus receives from the terminal apparatus a predetermined packet and transmits to the terminal apparatus a response to the predetermined packet.

Further, the SNMP Agent does not match the identification information included in the predetermined packet with identification information of the scanner apparatus, as admitted by the Examiner in the Official Action mailed on August 23, 2005. Thus, claims 16-25 are clearly distinguished over ROY et al.

Therefore, it is respectfully submitted that the features recited in Applicant's submitted claims 16-25 is not disclosed in ROY et al. cited by the Examiner. Claim 15 is also submitted to be patentable over the Examiner's proposed combination, since neither of RODWIN et al., ITOH, SAWYER et al., and ROY et al., nor any proper combination thereof, disclose the combination of features recited in Applicants' claims 16-25.

KUMPF et al. relates to a network peripheral server discovery method for discovering peripheral servers that a peripheral specific software can utilize.

However, KUMPF et al. does not disclose a scanner apparatus which transmits, to the terminal apparatus, a response to the predetermined packet when the identification information included in the predetermined packet matches identification information of the scanner apparatus. Rather, in KUMPF et al., the client 12 displays a list of peripherals 16 attached to the servers 10, and a user at the client 12 selects a

peripheral, e.g., a scanner (col. 4, lines 47-63). In other words, the scanner does not transmit, to the client 12, a response to a predetermined packet, but the scanner is merely selected by the user at the client, via the list of peripherals displayed on the client 12. Thus, claims 16-25 are clearly distinguished over KUMPF et al.

Therefore, it is respectfully submitted that the features recited in Applicant's submitted claims 16-25 are not disclosed in KUMPF et al. cited by the Examiner. Claims 16-25 are also submitted to be patentable over the Examiner's proposed combination, since neither of RODWIN et al., ITOH, SAWYER et al., ROY et al., and KUMPF et al., nor any proper combination thereof, disclose the combination of features recited in Applicants' claims 16-25.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections, and requests an indication of the allowability of all the claims pending in the present application, in due course.

Although the status of the application is after final rejection, Applicant submits that entry of the present amendment is proper under 37 C.F.R. § 1.116. In particular, no new issues requiring further search or consideration are being presented. As previously noted, the amendments to the claims merely further emphasize a previously recited feature of the claims and thus do not raise any new issues requiring further consideration or search.

SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has amended the rejected claims and submits the same for reconsideration by the Examiner. With respect to the pending claims, Applicant has pointed out the features thereof and has contrasted the features of the claims with the disclosures of the applied references. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

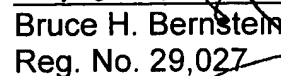
The amendments to the claims which have been made in this amendment, which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,  
Yutaka IYOKI



William Pieprz  
Reg. No. 33,630



Bruce H. Bernstein  
Reg. No. 29,027

November 9, 2005  
GREENBLUM & BERNSTEIN, P.L.C.  
1950 Roland Clarke Place  
Reston, VA 20191  
(703) 716-1191